

JUL 21 2005

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TO:	Examiner L. Tran Group Art Unit 2853		
FROM:	Michael K. O'Neill		
RE:	U.S. Application No. 09/661,388 Atty. Docket No.: 03690.000066		
FAX NO.:	(571) 273-8300		
DATE:	July 21, 2005	NO. OF PAGES:	4 <small>(including cover page)</small>
TIME:	3:45	SENT BY:	<i>Sharm</i>

MESSAGE

Attached is a Response to Requirement for Election Between Species and Request for Clarification of the Requirement dated June 21, 2005.

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(Name of Attorney for Applicant)

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03690.000066

JUL 21 2005 PATENT APPLICATION**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:)
: Examiner: L. Tran
KENTARO ONUMA, et al.)
: Group Art Unit: 2853
Application No.: 09/661,388)
:
Filed: September 13, 2000)
:
For: IMPROVED PRINT HEAD)
RECOVERY : July 21, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO REQUIREMENT FOR ELECTION BETWEEN SPECIES
AND
REQUEST FOR CLARIFICATION OF THE REQUIREMENT**

Sir:

In response to the Requirement for election between species, dated June 21, 2005, Applicants hereby provisionally elect to prosecute species 2, namely Claims 12 to 23 and 53 to 64. The requirement is respectfully traversed.

Traversal is on the grounds that the Office Action has not established any of the factual predicates needed to impose such a requirement. In particular, since this is a

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requirement to elect between species, and since species are always specifically different embodiments of the invention, the PTO is required to identify the specifically different embodiments described in the specification. This was not done. Rather, the PTO relied on claim language to "manufacture" different embodiments, despite the fact that nearly the entire specification is devoted to a single disclosed embodiment. It is simply not permitted to equate different species to different claims. See MPEP § 806.04(e):

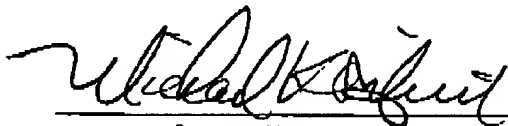
"Claims are definitions of inventions ... *Claims are never species*. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*). '*Species are always the specifically different embodiments*.'" (Emphasis in original.)

Since the Office Action did not identify any of the "specifically different embodiments" as it was required to do, the requirement to elect is faulty and should be withdrawn. For this reason, clarification is respectfully requested on the basis for the requirement.

This matter was brought to the Examiner's attention in a telephone message placed on July 8, 2005, but did not result in a resolution of the matter. Rather, pursuant to a telephone message left by the Examiner on July 15, 2005, the Examiner was of the opinion that the requirement to elect was proper and should be responded to formally. Since, as demonstrated above, it is Applicants' belief that the requirement for election is faulty, and does not establish any of the factual predicates necessary for its imposition, the Examiner is respectfully requested to reconsider her position and to issue an Office Action consonant with the guidelines set out in the MPEP.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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